



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,642	06/18/2001	Denisa D. Wagner	CFBF-P02-004	3076

28120 7590 07/27/2004

ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

EXAMINER

GAMBEL, PHILLIP

ART UNIT	PAPER NUMBER
----------	--------------

1644

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

3M.

Office Action Summary

Application No.

09/883,642

Applicant(s)

WAGNER ET AL.

Examiner

Phillip Gambel

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application. 39-52, 61-68, 71-73, 76-79
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement. 39-52, 61-68, 71-73, 76-79

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1644

DETAILED ACTION

1. Applicant's Brief on Appeal, filed 5/18/04, is acknowledged.

However, it appears that there is an apparent discrepancy as to the elected invention.

The examiner has been interpreting that the elected claimed methods read on the use of antibodies that bind P-selectin and not antibodies that bind P-selectin and E-selectin nor L-selectin.

In contrast, it appears that applicant has been interpreting that the elected claimed methods read on the use of antibodies bind P-selectin and E-selectin as well as L-selectin.

Further, it is noted that the dependent claims 62-65 are subject to a rejection under 35 USC 112, second paragraph, since they read on antibodies that bind P-selectin or E-selectin and not on antibodies that bind both P-selectin and E-selectin as well as L-selectin.

Furthermore it is noted that the claimed recitation of antibodies that bind P-selectin and E-selectin may be subject to a rejection under 35 USC 112, first paragraph, written description / new matter.

While the instant specification as filed appears to support agents that inhibit the interactions between P-selectin and a ligand for P-selectin and between E-selectin and a ligand for E-selectin as well as between L-selectin and a L-selectin ligand, the written support for P-selectin antibodies that inhibit the interactions between P-selectin and a ligand for P-selectin and between E-selectin and a ligand for E-selectin as well as between L-selectin and a L-selectin ligand is not readily apparent. For example, page 9 of the instant specification appears to disclose only those P-selectin antibodies that inhibit interactions between P-selectin and a P-selectin ligand and not on P-selectin antibodies that bind E-selectin and L-selectin.

Applicant should provide clear direction and guidance to the written support of the instant claims as they read on the use of P-selectin antibodies that inhibit the interactions between P-selectin and a ligand for P-selectin and between E-selectin and a ligand for E-selectin in the specification as well as between L-selectin and a L-selectin ligand as filed to avoid a new matter rejection under 35 USC 112, first paragraph.

The examiner apologizes for any convenience to applicant in this matter.

2. Given the apparent discrepancy between the examiner and applicant with respect to the elected invention, the following species election is set forth as they read on the instant claims.

However, applicant is reminded that the claimed species drawn to the use of P-selectin antibodies that inhibit the interactions between P-selectin and a ligand for P-selectin and between E-selectin and a ligand for E-selectin as well as between L-selectin and a L-selectin ligand may be subject to a new matter rejection under 35 USC 112, first paragraph, written description / new matter.

Art Unit: 1644

With respect to originally elected invention that read on the use of P-selectin antibodies in the claimed methods, this application contains claims directed to the following patentably distinct species of the claimed invention: wherein the P-selectin antibody:

- A) binds P-selectin and inhibits the interactions between P-selectin and a ligand for P-selectin,
- B) binds P-selectin and inhibits the interactions between P-selectin and a ligand for P-selectin and between E-selectin and a ligand for E-selectin or
- C) binds P-selectin and inhibits the interactions between P-selectin and a ligand for P-selectin and between E-selectin and a ligand for E-selectin as well as between L-selectin and a ligand for L-selectin.

These species are distinct because the P-selectin antibodies bind discrete targets and have discrete functional properties. Therefore, they are separate and patentably distinct species

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 39 is generic, for example.

3. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

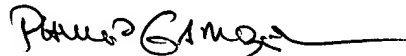
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Art Unit: 1644

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (571) 272-0844. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.0

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phillip Gambel, Ph.D.
Primary Examiner
Technology Center 1600
July 23, 2004



CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600